

### **REMARKS**

The Applicants have amended Claims 1, 19, and 23 to remove the plurality of cells limitation and to add the limitation of an electrical stimulation generator configured to apply a potential difference to electrodes to provide a non-rotating electric field having a strength high enough to modulate cells' transmembrane potentials but not high enough to cause electroporabilization of the cells' membranes. Support for the electrical stimulation generator limitation may be found in the specification, for example, from page 31, line 29 to page 33, line 12. Claims 1, 3, 6-8, 10-13, and 19-41 remain pending in the application. The Applicants have carefully considered all of the Examiner's rejections and remarks but respectfully submit that the claims are allowable for at least the following reasons.

#### **Rejections under § 102 and § 103**

The Examiner rejected Claims 1, 3, 6-8, 10, 13, and 19-22 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Baer et al. (U.S. Patent No. 5,128,257). The Examiner rejected Claims 19-22 under 35 U.S.C. § 102(b) as being anticipated by Arnold et al. (U.S. Patent No. 4,801,543). The Examiner rejected Claims 11, 12, 32, and 33 under 35 U.S.C. § 103(a) as being obvious over Baer in view of King et al. (U.S. Patent No. 6,352,853) and Claims 23-31, 34-39, and 41 as being obvious over Baer in view of Matschke (U.S. Patent No. 4,699,881) or Hilliard et al. (U.S. Patent No. 4,695,547). The Examiner rejected Claim 40 under 35 U.S.C. § 103(a) as being obvious over Baer in view of Papp et al. (U.S. Patent No. 5,422,272).

The Examiner indicated that prior claim limitations directed to how potential differences are applied to cells and how the cells respond were only the intended use of the apparatus and thus were not considered in determining patentability. The Applicants have now amended the claims to recite an electrical stimulation generator configured to apply a potential difference to electrodes in order to provide a non-rotating electric field having a strength high enough to modulate cells' transmembrane potentials but not high enough to cause electroporabilization of the cells' membranes. This claim limitation, which is a structural limitation defined by certain

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functional characteristics, must be given full weight in determining patentability. In *In re Schreiber*, 128 F.2d 1473, 1478 (Fed. Cir. 1997), it was stated that "[a] patent applicant is free to recite features of an apparatus either structurally or functionally." The *Schreiber* court found that the examiner and the Board had properly "addressed the question whether the functional limitations" in the claim at issue "gave it patentable weight." *Id.* (finding that because the functional limitations were inherently found in the prior art, the claim was anticipated). Accordingly, the Examiner in the instant case should compare the claimed electrical stimulation generator, which is configured to apply an electric field having specified characteristics, with the prior art to determine if generators having the same characteristics are disclosed explicitly or inherently. The Applicants respectfully submit that none of the prior art cited by the Examiner disclose or suggest an electrical stimulation generator that is specifically configured to generate an electric field that is non-rotating and low enough to not cause electroporation. Accordingly, the pending claims are patentable over the cited prior art.

### CONCLUSION

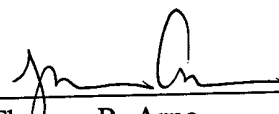
For the foregoing reasons, the Applicants submit that the claims are in condition for allowance and respectfully request a timely issuance of a Notice of Allowance.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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